

PATENT APP. NO. 10/074,028

ATTY. DOCKET NO. 53394.000566

AMENDMENT IN RESPONSE TO 2/8/05 OFFICE ACTION

III. REMARKS/ARGUMENTS

A. Status of the Claims

Claims 1-37 are pending in the application. Claims 3-4, 17-25, and 34-37 have been withdrawn from consideration. Claims 1-2, 5-16, and 26-33 stand rejected by the Examiner. By this amendment claims 1, 8, 28, 32, and 33 are amended. No new matter is added. Applicant respectfully requests reconsideration of the rejections of claims 1-2, 5-16, and 26-33 for at least the following reasons.

B. Claim Rejections

1. Claim Rejections under 35 U.S.C. § 102

Claims 1-2, 5-10, 13, 26, 28, and 32-33 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,628,738 to Suekane ("Suekane"). The Applicants respectfully traverse this rejection and request reconsideration and allowance of the pending claims in view of the following remarks.

A claim is anticipated by a reference only if "each and every element as set forth in the claim is found, either expressly or inherently described" in the reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). With respect to claim 1, the Office Action alleges that Suekane discloses every element of claim 1 because

the claimed limitation requiring that at least a portion of the side seam is curved when the first and second side portions are in a stretched condition is a recitation of the intended use of the claimed invention. This recitation must result in a structural difference between the claimed invention and the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. . . See *In re Casey*, 370 F.2d 576, 152 U.S.P.Q. 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 U.S.P.Q. 458, 459 (CCPA 1963). The article of Suekane is fully capable of performing the recited function.

Office Action at page 3 (emphasis added). However, the Applicant respectfully submits that the claimed invention and the prior art are structurally different because Suekane does not disclose a side seam that is at least partially curved as recited in claim 1.

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Suekane relates to a method of welding a disposable diaper along the laterally opposed side edges in the waist region. As shown in Figures 1 and 2 (reproduced below for the Examiner's convenience), Suekane discloses a pant-type absorbent article (reference number 1 in Figure 1, 1A in Figure 2) having a front waist portion (5) and a rear waist portion (6), with wing-like portions (21, 22) extending outwardly from the lateral side edges in the front and rear waist portions. See Suekane, col. 2, ll. 35-60. The front and rear waist portions are welded together with an ultrasonic intermittent weld line (reference number 15 in Figure 1); each ultrasonic weld line extends vertically along the lateral sides of the waist portions. Suekane, col. 2, lines 46-53.

FIG.1

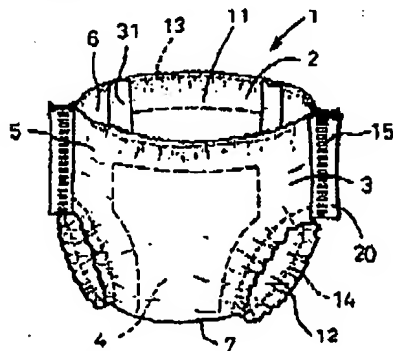
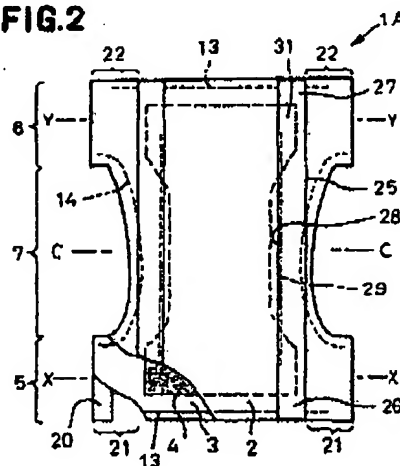


FIG.2



In contrast, independent claim 1 of the pending application recites an absorbent article having a pair of elastic side panels that are attached by a side seam, at least a portion of the side seam being curved when the first and second side portions are in a fully-extended condition. Referring to Figure 24 (reproduced below for the Examiner's convenience), absorbent garment (1500) has side panels (1560) extending outward from the main body. Specification, page 49, ll. 20-22. Each side panel has a first side portion (1566) that has an outer lateral side panel edge (1572), and a second side portion (1574) that has an outer lateral side panel edge (1580). *Id.* at p. 49, l. 26 - p. 50, l. 4. The first

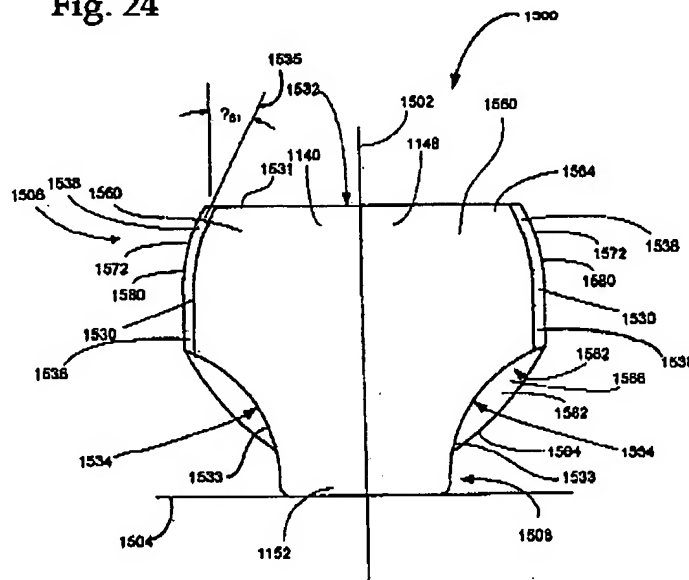
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and second side portions are joined by the formation of the side seam (1530), which is formed with the first and second side seam portions are in a fully-stretched position. *Id.* at p. 50, ll. 10-14. In order to clarify the recited feature consistent with the specification, independent claim 1 has been amended to recite "at least a portion of the side seam being curved when the first and second side portions are in a fully-extended condition." This amendment is fully supported by the Specification, at page 50, lines 12-14.

Fig. 24



As shown in Figure 24, each side seam has a straight portion (1536) adjacent the leg opening (1534) and a curved portion (1538) adjacent the waist opening (1532). *Id.* at p. 51, ll. 3-5. "The partially curved side seam 1530 causes the completed side panels 1560 to adopt a pre-formed curvature that is not provided by previous garments having straight seams or seams formed only from straight segments." *Id.* at p. 50, l. 28 - p. 51, l. 2. The curved portion of the side seam "serves to enhance the comfort and fit by better conformance with the body curves of the wearer." *Id.* at p. 51, ll. 6-7.

Suekane does not disclose an absorbent garment having a side seam, where at least a portion of the side seam is curved when the first and second side portions are in

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a fully-extended condition. The side seams of Suekane are formed by an ultrasonic intermittent weld "line . . . [that] vertically extend[s] along the lateral sides of the waist portions," Suekane, col. 2, ll. 50-53; *see also* Figure 1 (the weld line 15 is vertical and linear). In fact, Suekane does not disclose a weld line that is anything other than linear. Even the edges adjacent to the weld line are linear — as shown in Figure 2, the lateral edges of the wing portions (21, 22) of the front/rear waist portions (5, 6) in the diaper's unfolded position are linear. Thus, as indicated by the unfolded configuration shown in Figure 2, the weld line would remain linear when the wing portions are in a fully-extended configuration. The only curved edges shown in Suekane are the leg openings (12) of the crotch zone (7) — but the curved leg openings are not part of the vertically-extending linear weld lines, as shown in Figure 1.

In summary, the Applicant respectfully submits that Suekane does not anticipate claim 1 because Suekane does not disclose an absorbent garment having a side seam, where at least a portion of the side seam is curved when the first and second side portions are in a fully-extended condition. Like claim 1, independent claim 28 recites an absorbent article having a pair of side seams, where at least a portion of each side seam is curved when the first and second side portions of the associated side panel are in a fully-extended conditions. Because Suekane also does not disclose an absorbent article having a pair of side seams, where at least a portion of each side seam is curved when the first and second side portions are in a fully-extended condition, the Applicant respectfully submits that Suekane also does not anticipate claim 28. Claims 2, 5-10, 13, 26, and 32-33 depend from claim 1 or claim 28, and therefore are also not anticipated by Suekane. Therefore, the Applicant respectfully requests that the Examiner reconsider and withdraw this rejection with respect to claims 1-2, 5-10, 13, 26, 28, and 32-33.

2. Claims Rejections under 35 U.S.C. § 103

Claims 11-12, 14-16 and 29-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Suekane. The Applicant respectfully traverses this rejection and

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requests reconsideration and allowance of the pending claims in view of the following remarks.

Three criteria must be met to establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations. See MPEP § 2142 *et seq.* Applicant respectfully submits that Suekane does not teach or suggest all of the claim limitations, because Suekane does not teach or suggest a side seam that is at least partially curved.

As discussed above, Suekane fails to disclose an absorbent article having a side seam, where at least a portion of the side seam is curved when the first and second side portions are in a fully-extended condition, as recited in independent claims 1 and 28, from which claims 11-12, 14-16, and 29-31 depend. Rather, Suekane teaches only a vertically-extending linear weld line. Suekane, col. 2, ll. 50-53. The Applicant has found that a side seam that is at least partially curved is superior to a linear side seam as disclosed in Suekane. "The partially curved side seam 1530 causes the completed side panels 1560 to adopt a pre-formed curvature that is not provided by previous garments having straight seams or seams formed only from straight segments." Specification, p. 50, l. 28 - p. 51, l. 2. The curved portion of the side seam "serves to enhance the comfort and fit by better conformance with the body curves of the wearer." *Id.* at p. 51, ll. 6-7. In accordance with this discovery, the Applicant has described and claimed various embodiments that provide an improvement over the prior art linear side seams.

Because Suekane does not teach or suggest all of the claim limitations, (*i.e.*, a side seam that is at least partially curved when the side portions are in a fully-extended condition) the Applicant respectfully submits that claims 11-12, 14-16, and 29-31 are patentable over Suekane. Therefore, the Applicant respectfully requests that the Examiner reconsider and withdraw this rejection with respect to claims 11-12, 14-16, and 29-31.

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IV. CONCLUSION

The Applicant respectfully submits that the application is in condition for allowance. Should any outstanding issues remain, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,
HUNTON & WILLIAMS LLP

Dated: 8 June, 2005

By:

Betsy Johnson
Betsy Johnson
Registration No. 55,305

Hunton & Williams LLP
1900 K Street, N.W., Suite 1200
Washington, D.C. 20006-1109
(703) 714-7627 - direct
(703) 714-7410 - fax